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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/756,106 | 01/09/2001 | Joseph M. Cannon | 20-140 | 5625 |

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FARKAS & MANELLI, PLLC
7th Floor
2000 M Street, N.W.
Washington, DC 20036-3307

| EXAMINER |
|---|
| CRAVER, CHARLES R |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2682 | 6 |

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/756,106 | Cannon et al |
| **Examiner** | **Art Unit** |
| Charles Craver | 2682 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *Jan 9, 2001* is/are a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Liu, US Pat 6,289,218.

**Claim 1:** Liu discloses a wireless piconet device 15, comprising

inherently, a piconet front end,

an address, and

means for a user to provide an identification number (reads PIN) associated with an address of one other wireless piconet device within range of said network device (col 2 lines 5-46).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 1 above, and further in vie of Mauney et al, US Pat 6,484,027.

**Claim 2:** Liu discloses applicant's invention, but fails to disclose an address list associated with the PIN.

Mauney discloses a wireless piconet device (38) comprising a unique ID (col 12 lines 19-42, col 17 lines 14-34), and means to allow a user to view an address list associated with other paired piconet devices stored in the device (col 16 lines 6-36). Mauney further discloses that an overall list of associated piconet devices may be grouped into different subgroups (col 29 lines 51-67, col 52 lines 9-21) for the purpose of communications, and that each group may have a different purpose (family, coworker, friend).

Therefore, given the suggestion of Mauney, and the popularity of address lists in portable phones, it would have been obvious given the grouping of the Mauney invention to allow a user

to select a list by using a selection module allowing the user to select a particular said subgroup using, for example, the display, in order to facilitate the communication taught by Liu by allowing efficient grouping of addresses.

**Claims 3 and 6:** Mauney discloses a number of subgroups, each of which would thus have corresponding names/passcodes and a corresponding number of piconet device ID entries.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 1 above, and further in view of Brown et al, US Pat 6,366,622.

While disclosing applicant's invention of claim 1 above, Liu fails to disclose the use of Bluetooth.

Brown discloses that Bluetooth was a well-known short-range RF standard at the time of the invention, asserting that the use of the Bluetooth protocol in a piconet device offered a robust communication (col 3 lines 10-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bluetooth into Liu, as it would, as suggested by Brown, make the connection more robust.

7. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 1 above.

**Claim 5:** the size of the address would have been a routine engineering decision predicated on the security desired, and as such the use of 6-byte addresses would have been an obvious modification of Liu.

8. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Mauney et al.

Liu discloses a wireless piconet device 15 and method for operating it, comprising means for a user to provide an identification number (reads PIN), and means for providing to the device an address associated with an address of one other wireless piconet device within range of said network device (col 2 lines 5-46).

Liu fails to disclose an address list associated with the PIN, that is, that a number of connected devices may be associated with said PIN.

Mauney discloses a wireless piconet device (38) comprising a unique ID (col 12 lines 19-42, col 17 lines 14-34), and means to allow a user to view an address list associated with other paired piconet devices stored in the device (col 16 lines 6-36). Mauney further discloses that an overall list of associated piconet devices may be grouped into different subgroups (col 29 lines 51-67, col 52 lines 9-21) for the purpose of communications, and that each group may have a different purpose (family, coworker, friend).

Therefore, given the suggestion of Mauney, and the popularity of address lists in portable phones, it would have been obvious given the grouping of the Mauney invention to allow a user

to select a list by using a selection module allowing the user to select a particular said subgroup using, for example, the display, in order to facilitate the communication taught by Liu by allowing efficient grouping of addresses.

9. Claims 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Mauney as applied to claim 7 above, and further in view of Brown et al.

**Claim 9:** While disclosing applicant's invention of claim 7 above, Liu fails to disclose the use of Bluetooth.

Brown discloses that Bluetooth was a well-known short-range RF standard at the time of the invention, asserting that the use of the Bluetooth protocol in a piconet device offered a robust communication (col 3 lines 10-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bluetooth into Liu in view of Mauney, as it would, as suggested by Brown, make the connection more robust. **Claim 8:** since Brown discloses Bluetooth may send both voice and data, sending address data from one device to another would have been an obvious use of said network. **Claim 10:** Brown discloses that Bluetooth-enabled devices may be a master or slave device (col 4 lines 14-37).

10. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Mauney as applied to claim 11 above, and further in view of Brown et al.

Please see the rejections of claims 8-10 above.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marko discusses direct communication.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached on (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

cc

C. Craver
July 26, 2003

1-26-03
CHARLES CRAVER
PATENT EXAMINER